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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
10/663,979	09/17/2003	Daniel M. Marks	110293.133US1	1953												
7590 Daniel M. Marks c/o HIGH 5 GAMES 150 Airport Exec. Pk-Ste 2 Nanuet, NY 10954		05/17/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">THOMASSON, MEAGAN J</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>3714</td><td></td></tr><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>05/17/2007</td><td>PAPER</td></tr></table>		EXAMINER		THOMASSON, MEAGAN J		ART UNIT	PAPER NUMBER	3714		MAIL DATE	DELIVERY MODE	05/17/2007	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,979

Applicant(s)

MARKS ET AL.

Examiner

Meagan Thomasson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 5, 2007 has been entered.

Response to Amendment

The examiner acknowledges the amendments made to claim 29, filed March 25, 2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 29 –31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benett (US 6,585,264 B2) in view of Bussick et al. (US 7,070,502 B1).

Benett discloses an electronic gaming device and method wherein a player places a wager, a plurality of symbols are arranged and displayed, including wildcard symbols, wherein said wildcard symbols are expandable in a plurality of directions. The player is then awarded based on various symbol combinations. The direction of the wildcard symbol expansion may be upwards, downwards, leftwards, rightwards or diagonally from the symbol position in which the wildcard symbol appears (see Figs. 3-8). Each of the symbols has a predetermined movement pattern, and are therefore expandable in a direction associated with the symbol (col. 1, lines 62-65). Upon completion of the symbol expansion process, a player may then be awarded a prize for obtaining a winning symbol combination (col. 2, lines 30-32).

Column 3, lines 43-51, describe the gaming method as upon the occurrence of a wildcard symbol, referred to by Benett as a chess symbol, the wildcard symbol will "make one move, i.e. from its initial position to a following display position, according to its normal chess movement pattern. If there is more than one direction in which such a move can be made, then, initially, one direction of movement is randomly selected by the controller 44 of the gaming machine 10. As the chess piece moves to each position in its pattern, it being understood that there is an underlying symbol at each such

position, in changes the underlying symbol to that chess piece. When it has completed its move, all wins will be paid in which one or more of the chess pieces substitutes”.

Additionally, Benett discloses automatically expanding wildcard symbols, if displayed in the symbol matrix, as col. 1, lines 57-59 state that “The control means may be pre-programmed to make the determination so that, in effect, the determination is predetermined”. In other words, Benett contemplates an embodiment wherein no decisions as to the possibility of movement or the direction of movement are made by the processor, and pre-determined movement patterns are executed automatically.

Further, Benett discloses always replacing the symbols in col. 2, lines 15-19, wherein “When the chess piece moves according to its movement pattern it may require any standard symbol is a display position in the movement pattern of the chess piece to which the chess piece moves and may act as a substitute for such standard symbol”, as well as in col. 3, lines 47-50, wherein “As the chess piece moves to each position in its pattern, it being understood that there is an underlying symbol at each such position, it changes the underlying symbol to that chess piece”.

Benett does not specifically disclose automatically expanding wildcard symbols, if displayed in the symbol matrix, in all of the predetermined directions associated with each said wildcard symbol. Specifically, Benett discloses that is there is more than one possible direction of movement associated with a wildcard, then the direction of movement is selected by the controller (col. 3, lines 44-47). In an analogous symbol expansion slot machine game, Bussick contemplates an embodiment wherein a wildcard symbol expands to fill a row containing said wildcard symbol. That is, referring

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to Fig. 7A, a "W" wildcard symbol is shown in the second row of the slot machine display. In Fig. 7B, it then expands to fill the entire row, including replacing all symbols in the path of the wildcard symbol. The directions of expansion associated with filling an entire row are expanding to the left and to the right, as shown in Fig. 7B. Thus, the wildcard symbols of Bussick expand in all pre-determined directions associated with the wildcard symbol. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Benett to include the feature wherein a wild symbol expands in all of the predetermined directions associated with said wildcard symbol, as this would increase the number of wildcard symbols on the board and thus provide more opportunities for the player to obtain a winning combination. This would increase player excitement and enjoyment of the game, which is an objective of Benett (col. 1, lines 13-28), as well as Bussick (col. 2, lines 28-30).

Regarding the limitation of claim 31, wherein the method described above further comprises a wildcard symbol expands N symbol position, from the symbol position in which the wildcard symbol appears towards the predetermined direction(s) assigned to the wildcard symbol, with N calculated in one of the following manners; N is a fixed number, N is a random number, or N is a random number selected from a range of numbers, Benett discloses that the number of symbols positions that the wildcard symbol expands into may be randomly determined (col. 3, lines 43-51).

Response to Arguments

Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive. Specifically, applicant argues that Benett cannot meet the limitations of the claims as it "relies upon the existence of a board game with pieces to provide movement patterns upon which to base the movement of the representation of said playing pieces" (Remarks, P. 5), and, by contrast, applicant's invention teaches expanding wildcard symbols in one or more predetermined directions without any regard to a board game or the movement patterns of pieces defined by said board game. This is not persuasive, as the board game serves only to illustrate the preferred embodiment of the game. As applicant's claimed invention does not disclose how predetermined movement directions are assigned to a wildcard symbol, the manner by which the prior art assigns predetermined movement directions is irrelevant. The invention disclosed by Benett is essentially the same as applicant's claimed invention.

Applicant's argument that Benett does not disclose expanding a wildcard symbol in predetermined directions associated with the symbol without requiring a control means to select one of the directions of expansion (Remarks, P. 6), is not persuasive. As cited above, Benett specifically discloses, "The control means may be pre-programmed to make the determination so that, in effect, the determination is predetermined" (col. 1, lines 57-59). Thus, Benett contemplates an embodiment wherein no decisions as to the possibility of movement or the direction of movement are made by the processor, and pre-determined movement patterns are executed automatically.

Applicant's argument that Benett does not disclose expanding the wildcard symbol such that all symbols in the expanded path are always replaced by the wildcard

symbol without the determination of a control means, (Remarks, P. 7), is not persuasive. The citations referred to by applicant to support this argument recite only one embodiment of the invention, said embodiment disclosing that "a determination may be made by the control means, when the chess piece is at said other position, as to whether or not a substitution is to be made" (col. 2, lines 19-29). However, immediately prior to the passage cited by applicant, Benett discloses an embodiment that does not require processor evaluation, wherein "When the chess piece moves according to its movement pattern it may replace any standard symbol in a display position in the movement pattern of the chess piece to which the chess pieces moves and may act as a substitute for such standard symbol" (col. 2, lines 15-19). Thus, the examiner also finds this argument to be not persuasive.

Finally, applicant argues that Benett does not meet the limitations of claim 29 as Benett teaches a game with a two-stage payment process in which the game pays before and after the movement pattern of a playing piece (Remarks, P. 8). This is not persuasive, as Benett in view of Bussick may disclose steps in addition to those recited in the claim, however, Benett in view of Bussick disclose all limitations of the claimed method, as recited above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert E Pezzuto
Supervisory Patent Examiner
Art Unit 3714

Meagan Thomasson
May 14, 2007